

ESTTA Tracking number: **ESTTA640860**

Filing date: **11/24/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

|                           |   |
|---------------------------|---|
| Proceeding                | 91193067  |
| Party                     | Plaintiff<br>Heidelberg University  |
| Correspondence<br>Address | GREGG W EMCH<br>MACMILLAN SOBANSKI & TODD LLC<br>720 WATER STREET, ONE MARITIME PLAZA<br>TOLEDO, OH 43604 1853<br>UNITED STATES<br>emch@mstfirm.com |
| Submission                | Motion to Suspend for Settlement Discussions  |
| Filer's Name              | Gregg W. Emch   |
| Filer's e-mail            | emch@mstfirm.com  |
| Signature                 | /Gregg W. Emch/   |
| Date                      | 11/24/2014  |
| Attachments               | 51094--Motion to Suspend _HU_.pdf(24885 bytes )   |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application Serial No. 77/636,839

Mark: HEIDELBERG UNIVERSITY

Filed: December 19, 2008

Publication Date: June 23, 2009

|   |   |                         |
|---|---|-------------------------|
| HEIDELBERG UNIVERSITY,                    | ) |                         |
|   | ) |                         |
| Opposer,                                  | ) |                         |
|   | ) |                         |
| v.  | ) | Opposition No. 91193067 |
|   | ) |                         |
| HEIDELBERG UNIVERSITY,                    | ) |                         |
|   | ) |                         |
| Applicant.                                | ) |                         |
| <hr style="width: 45%; margin-left: 0;"/> |   |                         |

**MOTION TO SUSPEND WITH CONSENT**

Opposer, Heidelberg University, hereby moves, with the consent of Applicant, to suspend the discovery and trial periods for 180 days, as follows:

|  |            |
|--|------------|
| Time to Answer:                          | CLOSED     |
| Deadline for Discovery Conference:       | CLOSED     |
| Discovery Opens:                         | CLOSED     |
| Initial Disclosures Due:                 | CLOSED     |
| Expert Disclosure Due:                   | 05/31/2015 |
| Discovery Closes:                        | 06/30/2015 |
| Plaintiff's Pretrial Disclosures:        | 08/14/2015 |
| Plaintiff's 30-day Trial Period Ends:    | 09/28/2015 |
| Defendant's Pretrial Disclosures:        | 10/13/2015 |
| Defendant's 30-day Trial Period Ends:    | 11/27/2015 |
| Plaintiff's Rebuttal Disclosures:        | 12/12/2015 |
| Plaintiff's 15-day Rebuttal Period Ends: | 01/11/2016 |

This request is necessitated by good cause, is not made for purposes of delay, and involves extraordinary circumstances. The parties acknowledge the Board's order dated September 30, 2014, and mutually insist that a suspension of proceedings is necessary, useful, and appropriate.

The parties have been actively negotiating a particular settlement framework since February of 2013. During this time, the parties have routinely exchanged proposals and engaged in extensive discussions regarding the details of this settlement framework. The settlement framework involves not only U.S. rights, but also international rights. The negotiation process has taken longer than desired because of the considerable number and complexity of issues involved. In addition, one of the parties is a foreign entity.

Since the Board's most recent order, the parties have reached an agreement in principle on the framework for a settlement that will resolve this opposition proceeding. However, the settlement still needs to be reduced to writing and put in final form for formal approval by the respective parties. Several aspects of this process are believed to necessitate a six-month suspension. At least one party will require formal approval of the settlement by its governing board of trustees. Furthermore, a number of minor details still require further discussions between the parties, though the parties feel confident these remaining issues will not prevent the final settlement from occurring.

The parties are closer to finally resolving this dispute than they ever have been in the past. Given this posture, the parties mutually desire to avoid the time and expense of engaging experts and conducting further discovery. Engaging experts and conducting further discovery would also detract from the efforts that will be needed to finalize the settlement agreement.

Should the Board wish for further details regarding the extraordinary circumstances present in this matter, the parties' attorneys are available for a conference call to discuss the current settlement negotiations at the convenience of the Board.

Heidelberg University has secured the express consent of all other parties to this proceeding for the suspension and resetting of dates requested herein.

Heidelberg University has provided an email address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board: [emch@mstfirm.com](mailto:emch@mstfirm.com) (Gregg W. Emch, attorney for Opposer) and [Lara.Holzman@alston.com](mailto:Lara.Holzman@alston.com) (Lara A. Holzman, attorney for Applicant).

Dated: Toledo, Ohio  
November 24, 2014

Respectfully submitted,  
MacMILLAN, SOBANSKI & TODD, LLC

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*Attorneys for Opposer*

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address of record by Facsimile or email (by agreement only) on November 24, 2014.

/Gregg W. Emch/  
Gregg W. Emch